

REMARKS

Claims 1, 2, 4 to 13, 79 to 82 and 93 to 108 are pending in this application. Claims 5 to 13, 79 to 82, 93 to 99, 101 to 103, and 105 to 108 have been withdrawn by the Office as directed to non-elected subject matter. Claim 3 has been canceled without prejudice. Claims 1 and 100 have been amended without prejudice to recite that the carrier-receiving portion at the first end comprises at least one flange. Support for these amendments can be found throughout the specification, e.g., at page 4, col. 2, paragraph 0060, of the published application. Claim 1 has also been amended without prejudice to incorporate the subject matter of claim 3, i.e., to recite that the second end is adapted to mate with a vessel such that the vessel is in fluid communication with the conduit. Support for this amendment can also be found throughout the application, e.g., at claim 3 and at page 5, col. 1, paragraph 0063, of the published application. No new matter has been added.

Previous Office Actions/Replies

To provide a clear record, although the present Office Action does not explicitly do so, applicants assume that the previous rejection of claims 1 to 4, 93, 97 to 100 and 104, as allegedly obvious over Mansour (U.S. Patent No. 6,057,165) in view of Goldstein (U.S. Patent No. 6,720,191) is withdrawn in view of applicants' arguments presented in their Reply filed on September 22, 2007.

35 U.S.C. §102(b)

Claims 1 to 3 and 100 have been rejected as allegedly anticipated by Ito (US Patent No. 5,063,025). Applicants do not agree that Ito anticipates the present claims. However, in the interest of moving the present application toward allowance, applicants have amended claims 1 and 100 without prejudice to recite that the carrier-receiving portion at the first end comprises at least one flange. Nowhere does Ito teach such an element. Further, amended claim 1 recites that the second end is adapted to mate with a vessel such that the vessel is in fluid communication with the conduit. Again, Ito does not teach such a feature. According to

applicants' specification (e.g., at page 5, col. 1, paragraph 0063), in certain embodiments, the second end is adapted for mating with a vessel, such as a centrifuge tube or a microtiter plate. Although the Office opines (at page 3) that the device of Ito is "structurally capable of mating with another vessel of suitable size and configuration," applicants submit that it is not adapted to mate with a vessel as described in applicants' specification because the device simply includes a needle at one end which according to Ito (at col. 1, lines 15 to 17) is used, e.g., to inject a sample into an analytical apparatus. Thus, for the reasons above, Ito does not anticipate amended claim 1 (or claims 2 and 3, which depend from claim 1) or amended claim 100. Accordingly, applicants respectfully request that the present rejection be reconsidered and withdrawn.

Claims 100 and 104 have been rejected as allegedly anticipated by Baer et al. (WO99/17094). Applicants do not agree that Baer anticipates the present claims. However, in the interest of moving the present application toward allowance, applicants have amended claim 100 without prejudice to recite "a carrier-receiving portion at a first end comprising at least one flange." Baer does not appear to teach such an element. Accordingly, Baer does not anticipate amended claim 100 (or claim 104, which depends from claim 100). Thus, applicants respectfully request that the present rejection be reconsidered and withdrawn.

35 U.S.C. §103

Claims 1 to 4 were rejected as allegedly obvious over Baer et al. (WO99/17094) in view of Silverstolpe (U.S. Patent No. 2,649,245). Applicants respectfully traverse this rejection because the Office has failed to establish a *prima facie* case of obviousness against amended claim 1.

As discussed above, amended claim 1 recites, e.g., an extraction device having a carrier receiving portion at a first end and a second end that is adapted to mate with a vessel such that the vessel is in fluid communication with a conduit. Baer discloses, *inter alia*, a biological reaction vessel that includes an analysis vessel, e.g., a microcentrifuge tube, and a cap (see, e.g., Figs. 11A-11D). Applicants read the Office Action to construe Baer's analysis vessel as equivalent to applicants' extraction device. Baer's analysis vessel, which can be, *inter alia*, a

microcentrifuge tube, clearly lacks a second end adapted to mate with a vessel such that the vessel is in fluid communication with a conduit that extends between a carrier-receiving end and the second end. As Baer seeks to provide a laser capture microdissection (LCM) consumable that integrates an LCM film into the interior of an analysis container and to reduce the amount of contamination involved with the LCM technique (see, e.g., Baer at page 4, lines 20 to 25), no skilled practitioner would have found any reason in Baer, or anywhere else in the art, to open Baer's analysis vessel and form an end adapted to mate with a second vessel.

Further, amended claim 1 recites that the carrier-receiving portion comprises at least one flange. Applicants' flange is illustrated in the specification at Figs. 1, 5 and 6, and described at page 4, col. 2, paragraph 0060 of the published application. The laser capture microdissection biological reaction vessel of Baer does not appear to include such a flange. Nor would Baer, or any other reference, provide skilled practitioners with any reason to include such a flange in the vessel of Baer.

Silverstolpe does not remedy the deficiencies of Baer. Silverstolpe describes, *inter alia*, improvements in stoppers as closing means for the end openings in vessels, e.g., centrifuge tubes (see Silverstolpe at col. 1, lines 1 to 7). Silverstolpe does not describe an extraction device that includes an end adapted to mate with a vessel. As it describes improved stoppers for centrifuge tubes, it would not have provided skilled practitioners with any reason to modify Baer's analysis vessel in an attempt to arrive at the present invention. Further, although Silverstolpe mentions a "flange," e.g., at col. 2, lines 48 to 53 and col. 3, lines 70 to 73, a comparison of Silverstolpe's Fig. 6 (to which passages of Silverstolpe recited above refer) to, e.g., applicants' Fig. 1, illustrates that Silverstolpe's "flange" appears to be a "collar" at one end of Silverstolpe's centrifuge tube and clearly different from the flange recited in the amended claims. Thus, applicants submit that no skilled practitioner would have found any reason in Baer or Silverstolpe, or anywhere else in the art, to modify Baer in an attempt to arrive at the present invention.

Further, applicants submit that even if Baer and Silverstolpe were combined, the combination would not have provided the present invention, because neither of these references

teaches or suggests all of the elements recited in the claims. As discussed above, amended claim 1 recites that the carrier-receiving portion comprises at least one flange and that the second end is adapted to mate with a vessel. Neither reference appears to disclose these elements. At best, a skilled practitioner combining these two references would have obtained, e.g., Baer's analysis vessel with a stoppered end, which is not the invention recited in amended claim 1. Thus, no combination of Baer and Silverstolpe renders the present invention obvious.

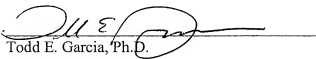
Accordingly, for the reasons discussed above, the Office has failed to establish a *prima facie* case of obviousness against the present claims. Applicants therefore request that the present rejection be reconsidered and withdrawn.

CONCLUSION

Applicants request that all rejections be reconsidered and withdrawn and that all claims be allowed. Enclosed is a Petition for a Three-Month Extension of Time. The fee in the amount of \$525.00 for the extension of time is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 14255-034001.

Respectfully submitted,

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